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RFC

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cleaners Products Supply, Inc.

Serial No. 76/369,765

Myron Amer for Cleaners Products Supply, Inc.

Andy Corea, Trademark Examining Attorney, Law Office 101
(Angela Wilson, Acting Managing Attorney).

Before Simms, Cissel and Quinn, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 14, 2002, applicant filed the above-referenced application to register the mark "TRUE COUNT POLYBAGS" on the Principal Register for "poly bags used in dry cleaning," in Class 30. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these products.

The Examining Attorney refused registration under Section 2(d) the Lanham Act, 15 U.S.C. 1052(d), on the

ground that if applicant were to use the mark it seeks to register in connection with the goods specified in the application, it would so resemble the mark shown below,



which is registered¹ for a "flexible plastic bag," in Class 20, that confusion would be likely. The original Examining Attorney reasoned that the marks are similar and the goods set forth in the cited registration encompass the products with which applicant intends to use the mark it has applied to register.

In addition to refusing registration under Section 2(d) of the Lanham Act, the Examining Attorney required applicant to disclaim the word "POLYBAGS" apart from the mark as shown because she found it to be merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Act. She also required amendment to the identification-of-goods clause and to the classification of

¹ Registration No. 555,598, issued on the Principal Register to Cadillac Products, Inc., a Delaware corporation, on March 4, 1952, and renewed three times. In the registration, registrant disclaimed the word "BAG" apart from the mark as shown.

applicant's goods. She suggested "poly propylene bags used for the storage of dry cleaning," in Class 22.

Applicant responded to the first Office Action by amending the application to identify its goods as "poly propylene bags used for transit of dry cleaning from a dry cleaning facility and subsequent storage in a closet," in Class 22. Applicant also complied with the requirement the Examining Attorney had made to disclaim the exclusive right to use "POLYBAGS" apart from mark as shown.

In addition to these amendments, applicant argued that confusion with the cited registration would not be likely because the marks, when considered in their entireties, possess significant differences in sound, meaning and appearance, and the goods identified by the registered mark are significantly different from those specified in the application, as amended.

The Examining Attorney accepted the amendments, but continued and made final the refusal to register under Section 2(d) the Act. Applicant timely filed a Notice of Appeal, along with its appeal brief. The newly assigned Examining Attorney² filed his brief in response, and

² The Examining Attorney identified in the heading of this opinion was assigned this case after the appeal was filed.

applicant filed a reply brief. Applicant did not, however, request an oral hearing before the Board.

The sole issue before us in this appeal is whether confusion with the cited registered mark would be likely if applicant were to use the mark it seeks to register in connection with the goods specified in the amended application. Based on careful consideration of the record in this application and the arguments presented by both the applicant and the Examining Attorney, we hold that the refusal to register is well taken.

In *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the similarity of the goods. Doubt as to whether confusion is likely must be resolved in favor of the registrant and prior user. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

In the instant case, confusion is likely because the marks create similar commercial impressions and the goods with which applicant intends to use its mark are

encompassed within the broad identification-of-goods clause in the cited registration.

When the goods or services in question are the same or closely related, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is not as great as it would be if the goods or services were not closely related. ECI Division of E Systems, Inc. v. Environmental Communications Inc., 207 USPQ 443 (TTAB 1980). The goods or services must be compared on the basis of the ways they are identified in the application and the cited registration, respectively. In re Elbaum, 211 USPQ 639 (TTAB 1981). In view of the fact that the goods identified in the cited registration encompass the products specified in the application, this case boils down to whether applicant's mark and the registered mark are so similar that they are likely to be confused.

Applicant argues that its "TRUE COUNT POLYBAGS" mark is not similar to the registered stylized "POLY BAG" mark because the only point of similarity is that applicant's mark includes the descriptive, and hence disclaimed, term "POLYBAGS." Applicant contends that the dominant portion of its mark, the words that will be used to order its products and to recommend them to others, will be "TRUE

COUNT," which apparently has significance in view of the sequential numbering applicant's bags will reveal as they are removed from the rolls on which they will be stored.

Whether this will actually occur is speculation at this point. What we do know is that applicant's mark essentially appropriates the entire registered mark (although pluralizing it) and adds to it words which appear to have suggestive or descriptive significance in connection with applicant's goods. Confusion is plainly likely under these circumstances. The commercial impressions of these two marks are quite similar. Purchasers of bags sold under the registered stylized "POLY BAG" mark would be likely, upon being presented with the mark "TRUE COUNT POLYBAGS" in connection with the same products, to assume, mistakenly, that the same source is responsible for both, and that "TRUE COUNT" bags are a product or a line of products made or sold by the same business which supplies the "POLY BAG" bags with which they are familiar.

Applicant posits the unpersuasive argument that because the term "POLYBAGS" is merely descriptive with regard to its goods, the word should be given less weight in the likelihood of confusion analysis. The registered "POLY BAG" mark is not the subject of any cancellation

proceeding of which we are aware, however, and as long as it remains a valid and subsisting registration, its validity may not be attacked in this collateral way.

When these two marks are considered in their entirety, the commercial impressions they engender are similar. Used on the same or virtually identical goods, they would be likely to be confused.

DECISION: The refusal to register under Section 2(d) of the Act is affirmed.